

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Osamu KANEHARA et al.

Application No.: 10/591,277

Filed: August 31, 2006



Group Art Unit: 3634

Examiner: J. REDMAN

Docket No.: 128934

For: GLASS RUN CHANNEL

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This request is being filed with a Notice of Appeal. Review of the December 3, 2009 Final Rejection is requested for the reasons set forth in the attached five or fewer sheets.

Should any questions arise regarding this submission, or the Review Panel believe that anything further would be desirable in order to place this application in even better condition for allowance, the Review Panel is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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Date: March 3, 2010

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REMARKS

Appellants hereby request review of the December 3, 2009, Final Rejection in this application.

In the Final Rejection, the drawings were objected to as failing to show every feature of the invention specified in the claims. Specifically, the Examiner asserts that the plurality of projecting ridges extending along a lengthwise direction must be shown or the features canceled from the claims. Appellants respectfully submit that the rejection is in error.

Specifically, reference to a plurality of ridges (30, 31) can be found at paragraph [0032] and Fig. 4. Thus, Appellants respectfully submit that the objection to the drawings is in error.

Additionally, in the Final Rejection, claims 1-11 were rejected under 35 U.S.C. §103(a) as being obvious over Applicants' Prior Art Figure 7 (sample no. 3) (hereinafter "AAPA") in view of Japanese Patent No. 10-026231 to Nagasawa. Appellants respectfully submit that the rejection is in error and should be withdrawn.

AAPA fails to disclose a plurality projecting ridges to be scalene triangle in shape as admitted on page 2 of the Final Rejection. However, the Examiner relies on Nagasawa for disclosure of this feature.

The Final Rejection asserts that Nagasawa discloses "a weather-strip (as shown in Figures 2 and 3) having projecting ridges to be scalene triangle in shape," and that it would have been obvious "to provide the ridges on Applicant's prior art Figure 7 with Scalene triangular ridges as taught [by Nagasawa]." See Final Rejection at page 2. Appellants respectfully disagree because Nagasawa is non-analogous art. Nagasawa relates to a sealing device used in a shaft seal part of an automobile power steering or the like as opposed to the claimed features which relate to guide structures for a glass run channel of a window frame.

"[A] reference in a field different from that of applicant's endeavor may be reasonably pertinent if it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his or her invention as a whole." See MPEP §2141.01(a). Appellants respectfully assert that the claimed projecting ridges would not have commended itself to one of ordinary skill in the art in considering the invention disclosed in Nagasawa. In particular, Nagasawa discloses projections (50, 60) of an oil seal (1) that is fitted into a cylinder (2) (Fig. 1). AAPA, however, recite a plurality of projecting ridges formed on the surface of a sealing lip body. The sealing lip body being formed on a glass run channel of a window frame of a vehicle. A glass run channel and an oil seal, while both being used in the vehicle industry, are completely unrelated fields of art that would not have been considered by one of ordinary skill in the art when considering AAPA. Thus, Applicants respectfully assert that Nagasawa is non-analogous art.

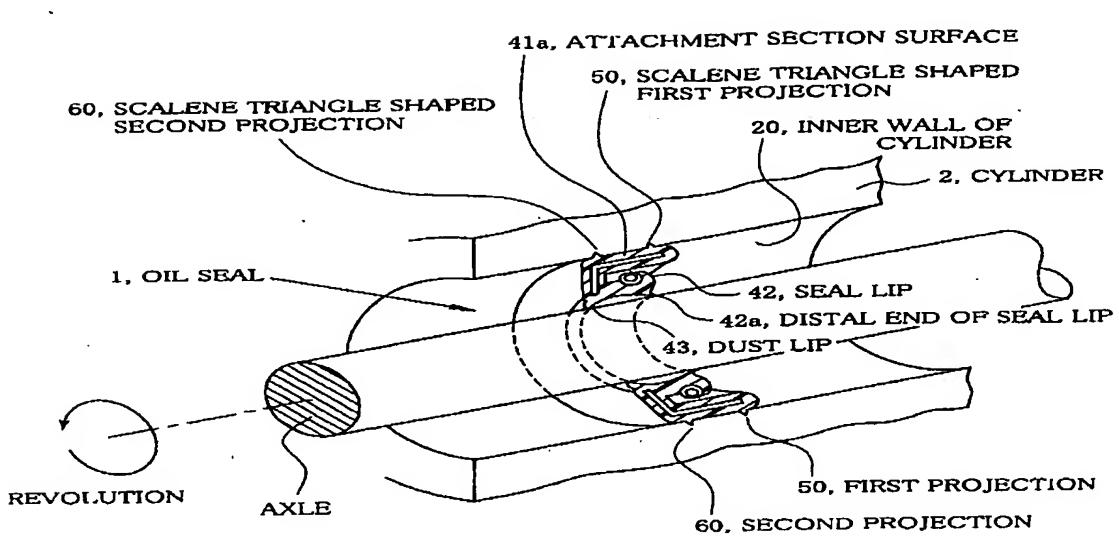
Additionally, the projections of Nagasawa perform a different function than the projecting ridges of AAPA. Thus, one of ordinary skill in the art would not have been motivated by the teaching in Nagasawa to modify the projecting ridges of AAPA as taught by Nagasawa.

For example, one of ordinary skill at the time of the invention would have understood that a significant aspect of the AAPA is to reduce the frictional force between the window pane and the sealing lip so as to improve a sliding performance and to prevent noise during the sliding of a window pane (paragraphs [0043] and [0044]). On the other hand, Nagasawa discloses projections provided in a manner such that foreign matter attached at a cylinder wall surface may reliably be scraped off when the oil seal is attached to the cylinder or so as to increase the frictional drag between the oil seal and a mounting surface (the inner circumferential surface of the cylinder) (paragraphs [0004], [0005] and [0026]).

In other words, the function of the projections in Nagasawa is to increase friction. In contrast, the function of the projecting ridges of AAPA is to decrease noise and thus, decrease the friction between the sealing lip and the window. Thus, one of ordinary skill at the time of the invention would not have been motivated, as proposed by the Examiner, to modify the projecting ridges of AAPA because the two structures (the AAPA projecting ridges and the Nagasawa projections) perform different functions, and therefore the teachings from one are not applicable to the other. Thus, the Examiner's assertion that "it would have been obvious to one of ordinary skill in the art at the time of the invention to provide the ridges of [AAPA] with scalene triangular ridges as taught by [Nagasawa]," is incorrect.

Additionally, Nagasawa fails to teach or suggest "projecting ridges have a cross-section formed into a shape of substantially a scalene triangle including a longer side at a root side of the sealing lip and a shorter side at a distal end of the sealing lip," as recited in claim 1. Specifically, the Examiner asserts that Nagasawa discloses a weather-strip with a plurality of projecting ridges to be scalene triangles in shape (Figs. 2 and 3). However, the projections of Nagasawa are not equivalent to the recited projecting ridges because Nagasawa does not provide its disclosed projections on a sealing lip of a glass run channel. Instead, Nagasawa discloses that the projections are provided on the attachment section surface (42) and not the sealing lips (42).¹ See Figure 1 illustrated below. Thus, Nagasawa fails to teach or suggest "projecting ridges have a cross-section formed into a shape of substantially a scalene triangle including a longer side at a root side of the sealing lip and a shorter side at a distal end of the sealing lip," as recited in claim 1.

¹ Please note that Fig. 1, 2 (a-d) and 3 (a, b) have incorrectly labeled both the attachment section surface and sealing lip as reference "42." However, based on the disclosure in paragraphs [0019] and [0022], it is understood that the reference character "42" on the left should be another reference character, for example, "41a."

**Figure 1²**

Additionally, Nagasawa fails to teach or suggest "a plurality of projecting ridges formed integrally on a surface of the sealing lip body so as to extend in a lengthwise direction of the sealing lip," as recited in claim 1. The projections of Nagasawa extend in the direction intersecting the lengthwise direction of the attachment section surface (41a) (refer to above Figure 1) as opposed to extending in the lengthwise direction of the sealing lip, as recited in claim 1. Thus, Nagasawa fails to teach or suggest "a plurality of projecting ridges formed integrally on a surface of the sealing lip body so as to extend in a lengthwise direction of the sealing lip," as recited in claim 1.

The Examiner's Final Rejection newly argues that Appellants argue against the references individually, and not the combination thereof. Appellants respectfully disagree.

As can be appreciated from the arguments presented above, Appellants have not argued against the references individually; instead, Appellants have explained the features

² As illustrated in Figure 1, Nagasawa discloses a distal end of seal lip (42a) that is in contact with an outer surface of a revolving axle to seal. On the other hand, first and second projections (50, 60) of Nagasawa are in contact with the inner wall of the cylinder (20), but these projections do not slide with respect to the inner wall of the cylinder.

and teachings of each reference as a whole to explain why it would not have been obvious to modify AAPA in view of Nagasawa as proposed by the Examiner.

It is the Examiner's Final Rejection that errs in its analysis of the references. The Examiner has failed to take into consideration how modifying the projecting ridges of AAPA to be like the projections of Nagasawa would make the projecting ridges of AAPA ineffective for their intended purpose.

Appellants clarify that AAPA's projecting ridges function to decrease noise and thus, decrease friction between the window pane and the sealing lip; whereas, Nagasawa's projections seek to increase the friction between the oil seal and the mounting surface. Thus, Appellants are not arguing against the references individually, but rather, are arguing that the combination is improper (based on the complete teachings of each reference) because one of ordinary skill in the art would not have been motivated to modify AAPA with the teaching of Nagasawa in the manner proposed by the Examiner.

Claims 2-11 are patentable by reason of their dependency from independent claim 1, as well as for the additional features recited therein.

For at least these reasons, withdrawal of the Final Rejection and allowance of the pending claims 1-11 are respectfully requested.